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**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Brian William HOLMES et al.

Group Art Unit: 2872

Application No.: 10/520,368

Filed: July 13, 2006

Docket No.: 122347

For: OPTICALLY VARIABLE SECURITY DEVICE

**RESPONSE TO DECISION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the March 13, 2007 Decision (copy attached) regarding the above named Applicants' June 28, 2006 Petition Under 37 C.F.R. §1.47(a) ("Petition"), the following information is provided.

Numerous attempts were made to locate a non-signing inventor, Dr. Kenneth John Drinkwater, in order to attempt to have him execute a Declaration regarding the above-identified application. In reply to these attempts, and after reviewing the specification and claims, Dr. Drinkwater, on July 13, 2007, provided information that he is not an inventor of the subject matter of the pending claims (see Dr. Drinkwater's attached letter). Therefore, the Petition is moot in light of this new information.

Dr. Drinkwater retired from the employment of the Assignee prior to submission of the PCT application (PCT/GB02/03174) on July 10, 2002. Dr. Brian William Holmes mistakenly, and without deceptive intent, identified his previous supervisor, Dr. Drinkwater, as an inventor of the subject matter of the pending claims. Mr. Holmes now acknowledges

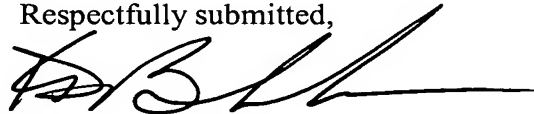
that Dr. Drinkwater provided only practical support and did not contribute to the invention of the subject matter of the pending claims.

Based on Dr. Drinkwater's statement, and Dr. Holmes' best recollection, as refreshed, and as discussed above, it is believed that Dr. Holmes is the sole inventor. Dr. Holmes submitted a signed Declaration in response to the May 3, 2006 Notice To File Missing Parts.

Because the reason for Applicants' Petition is mooted by the above-reviewed facts, no re-submission of Applicants' Petition is warranted. In order to ensure that the record is correct regarding this matter, Dr. Holmes re-executed the attached Declaration, and a corrected Application Data Sheet is provided.

Should any questions arise regarding this correspondence, all inquiries may be directed to Applicant's undersigned representative at the telephone number set forth below.

Respectfully submitted,



James A. Oliff  
Registration No. 27,075

Kirk D. Berkhimer  
Registration No. 59,874

JAO:KDB/mab

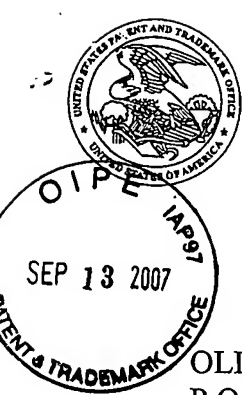
Attachments:

Copy of U.S. Patent and Trademark Office Decision mailed on March 13, 2007  
Statement of Dr. Drinkwater dated July 13, 2007  
Re-executed Declaration of the Inventor  
Corrected Application Data Sheet

Date: September 13, 2007

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461
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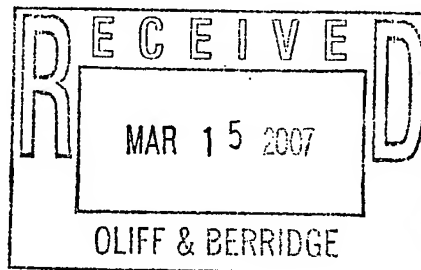
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13 MAR 2007

OLIFF & BERRIDGE, PLC  
P.O. BOX 19928  
ALEXANDRIA, VA 22320



In re Application of HOLMES et al  
U.S. Application No.: 10/520,368  
PCT Application No.: PCT/GB2002/003174  
Int. Filing Date: 10 July 2002  
Priority Date Claimed: (none)  
Attorney Docket No.: 122347  
For: OPTICALLY VARIABLE SECURITY  
DEVICE

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DECISION

This is in response to applicant's "Petition Under 37 C.F.R. §1.47(a)" filed 28 June 2006.

**BACKGROUND**

On 10 July 2002, applicant filed international application PCT/GB2002/003174. A copy of the international application was communicated to the USPTO from the International Bureau on 22 January 2004. The thirty-month period for paying the basic national fee in the United States expired on 10 January 2005.

On 06 January 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 03 May 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 28 June 2006, applicant filed the present petition under 37 CFR 1.47(a) along with an executed declaration.

**DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2)

factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by the available inventor on his own behalf and on behalf of the nonsigning inventor.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

\* \* \*

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventor Kenneth Drinkwater is considered unavailable after diligent effort. However, as evidenced by the certified mail receipt, Dr. Drinkwater was located at his last known address of record when he signed for the letter dated 27 January 2005. Thus, it cannot be concluded that Dr. Drinkwater cannot be found after diligent effort. Applicant is entitled to allege that Dr. Drinkwater refuses to sign the application papers, but no such claim has been made. It is noted that that the 27 January 2005 letter did not specify any due date for response and therefor would not alone serve as an adequate showing of a refusal to sign.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

**CONCLUSION**

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

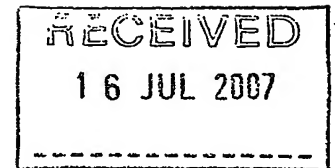
*Bryan Lin*

Bryan Lin  
PCT Legal Examiner  
PCT Legal Office

Telephone: 571-272-3303  
Facsimile: 571-273-0459



From John Drinkwater  
46 Guildford Road  
Fleet  
Hampshire  
GU51 3EY



13th July 2007

Attn Tim Berridge  
Divisional IP Manager  
De La Rue Holdings plc  
De la rue House  
Jays Close  
Bansingstoke  
Hants RG22 4BS

Dear Tim

Re : US patent application No 10/5200368  
Brian Holmes et al,  
Optically Variable Security Device.

Thank you for your letter of 22 June.

This is to confirm that I do not believe I am an inventor on this case and am happy to be removed as a named inventor on this particular case.

Yours sincerely

Dr K J Drinkwater

# DECLARATION UNDER 35 USC §371(c)(4) FOR PCT APPLICATION FOR UNITED STATES PATENT

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below under my name;

I verily believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought, namely the invention entitled: OPTICALLY VARIABLE SECURITY DEVICE

described and claimed in international application number PCT/GB 02/03174 filed July 10, 2002.

I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations §1.56.

Under Title 35, U.S. Code §119, the priority benefits of the following foreign application(s) filed by me or my legal representatives or assigns within one year prior to my international application are hereby claimed:

The following application(s) for patent or inventor's certificate on this invention were filed in countries foreign to the United States of America either (a) more than one year prior to my international application, or (b) before the filing date of the above-named foreign priority application(s):

ALL CORRESPONDENCE IN CONNECTION WITH THIS APPLICATION SHOULD BE SENT TO OLIFF & BERRIDGE, PLC, CUSTOMER NUMBER 25944, TELEPHONE (703) 836-6400.

I hereby declare that I have reviewed and understand the contents of this Declaration, and that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

1	<b>Typewritten Full Name of Sole or First Inventor:</b>	Brian	W.	Holmes
2	<b>Inventor's Signature:</b>	Given Name <i>Brian</i>	Middle Initial	Family Name
3	<b>Date of Signature:</b>	<i>10</i>	<i>9th</i>	<i>2002</i>
		Month	Day	Year
	<b>Residence:</b>	Fleet		United Kingdom
		City	State or Province	Country
	<b>Citizenship:</b>	British		
	<b>Post Office Address: (Insert complete mailing address, including country)</b>	"Gnomes Oak", Hitches Lane, Fleet, Hants, GU51 5HZ, United Kingdom		

Note to Inventor: Please sign name on line 2 exactly as it appears in line 1 and insert the actual date of signing on line 3.



# OLIFF & BERRIDGE, PLC

ATTORNEYS AT LAW

## Application Data Sheet

### Applicant Information

Applicant Authority type::	Inventor
Primary Citizenship Country::	U.K.
Status::	Full Capacity
Given Name::	Brian
Middle Name::	William
Family Name::	HOLMES
City of Residence::	Hants
Country of Residence::	United Kingdom

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Applicant Authority Type::	<del>Inventor</del>
Primary Citizenship Country::	<del>U.K.</del>
Status::	<del>Full Capacity</del>
Given Name::	<del>Kenneth</del>
Middle Name::	<del>John</del>
Family Name::	<del>DRINKWATER</del>
City of Residence::	<del>Hampshire</del>
Country of Residence::	<del>United Kingdom</del>

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### Correspondence Information

Correspondence Customer Number::	25944
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### Application Information

Application Type::	National Phase
Subject Matter::	Utility
CD-ROM or CD-R::	None
Title::	OPTICALLY VARIABLE SECURITY DEVICE
Attorney Docket Number::	122347
Total Drawing Sheets::	15
Small Entity::	No



## Representative Information

<b>Domestic Priority Information</b>			
Application::	Continuity Type::	Parent Application::	Parent Filing Date::
This Application is a	National Stage of	PCT/GB02/03174	07/10/2002
<b>Foreign Priority Information</b>			
Country::	Application Number::	Filing Date::	Priority Claimed::
<b>Assignee Information</b>			
Assignee Name::		DE LA RUE INTERNATIONAL LIMITED	
Street of mailing address::		De La Rue House, P.O. Box 10,	
		Jays Close, Viables,	
City of mailing address::		Basingstoke,	
State or Province of mailing address::		Hampshire	
Country of mailing address::		United Kingdom	
Postal or Zip Code of mailing address::		RG22 4BS	